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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JAMES A. JOHANSON, JOSEPH M. CANNON, and  
PHILIP D. MOONEY

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Appeal 2009-000929  
Application 09/777,884  
Technology Center 2400

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Decided: August 24, 2009

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Before JOSEPH L. DIXON, STEPHEN C. SIU, and  
DEBRA K. STEPHENS, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

The Patent Examiner rejected claims 3-5, 19, and 30-37. Claims 1-2, 6-18, and 20-29 have been canceled. The Appellants appeal the rejected claims under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## I. STATEMENT OF THE CASE

### *The Invention*

The invention at issue on appeal relates to a method and apparatus for allowing a user to select an electronic device to communicate with via Bluetooth signal based on the location of the electronic device (Spec. 1).

### *The Illustrative Claim*

Claim 19, an illustrative claim, reads as follows:

19. A method for selecting nearby devices to communicate with, comprising the steps of:

transmitting a first Bluetooth signal;

detecting a plurality of second Bluetooth signals, each containing GPS coordinates of at least one nearby device;  
and

selecting a nearby device associated with one of the detected signals to communicate with based on the received GPS coordinates.

### *The References*

The Examiner relies upon the following prior art as evidence in support of rejections:

Fumarolo	US 6,204,844 B1	Mar. 20, 2001
Bork	US 6,246,376 B1	Jun. 12, 2001

### *The Rejection*

The following rejection is before us for review:

Claims 3-5, 19 and 30-37 stand rejected under 35 U.S.C. § 103(a) as

being unpatentable over the Fumarolo and Bork.

Only those arguments actually made by the Appellants have been considered in this decision. Arguments which the Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

## II. ISSUE

Have the Appellants shown that the Examiner erred in determining that the combination of Fumarolo and Bork discloses “selecting a nearby device associated with one of the detected signals to communicate with based on the received GPS coordinates,” as recited in independent claim 19?

## III. PRINCIPLES OF LAW

### *Prima Facie Case of Unpatentability*

The allocation of burdens requires that the United States Patent and Trademark Office (USPTO) produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The Examiner bears the initial burden of presenting a prima facie case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Appellants have the opportunity on appeal to the Board of Appeals and Interferences (BPAI) to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

### *Scope of Claim*

The claim construction analysis begins with the words of the claim. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC., v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003) (internal citations omitted).

### *Obviousness*

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any the differences between the claimed subject matter and the prior art; and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

In determining obviousness, the *KSR* Court stated:

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

*KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

The Court reaffirmed the principle based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. The operative question in this “functional approach” is thus “whether the

improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

## VI. FINDINGS OF FACT

The following findings of fact (FFs) are supported by a preponderance of the evidence:

### *Fumarolo*

1. Fumarolo discloses that in a communication system 100 (Fig. 1), a user can use a display terminal to select a communication unit based on GPS coordinates (col. 13, ll. 32-42) and “the selection of the communication units may be performed on an individual basis or on a group basis.” (Col. 13, ll. 46-48.) Fumarolo further discloses that a user can use the display terminal for grouping or regrouping the selected communication units to different groups (Figs. 3-4) “to enable the users of the selected communication units to communicate directly with each other.” (Col. 14, ll. 5-6.)
2. Fumarolo further discloses the group of communication units may be used in a limited geographic area of the communication system (Figs. 3-4, col. 5, ll. 35-65).

### *Bork*

3. Bork discloses two or more portable wireless device with a Bluetooth unit and GPS receiver for communication and location information in a limited geographic area such as a shopping mall (Fig. 2, col. 2, ll. 25-38, col. 5, ll. 49-67).

## V. ANALYSIS

The Examiner has set forth a detailed explanation of a prima facie case of obviousness in the Examiner's Answer. Therefore, we look to the Appellants' Briefs to show error in the proffered prima facie case.

### *35 U.S.C. § 103(a)*

With respect to claim 19, the Appellants contend that Fumarolo fails to disclose "selecting a nearby device associated with one of the detected signals to communicate with based on the received GPS coordinates," in particular, "the selection in Fumarolo is not of a nearby device, but of a talk group." (App. Br. 4.) The Appellants further contend that

the selection of a talk group in Fumarolo is based on whether the communication units in the group desire to handle an incident, regardless of their location, GPS coordinates or whether they are nearby. Fumarolo's use of GPS information is to locate the device, not to select a nearby device to communicate with.

*(Id.)*

We disagree with the Appellants' contentions. We start our analysis with claim interpretation. The disputed claimed limitation is "selecting a nearby device . . . to communicate with based on the received GPS coordinates." The claim language does not limit selecting only one nearby device to communicate with others, nor prohibit putting the selected device into a group to communicate with others. In addition, a talk-group of communication units may consist

of only one communication unit and the claimed “nearby” device could include any device in a limited geographic area. We find that the claim limitation “selecting a nearby device . . . to communicate with based on the received GPS coordinates.” reads on Fumarolo, under our above claim construction. (FF 1.)

The Appellants further contend that “[o]ne of ordinary skill in the art would realize that the particular Bluetooth based system in Bork could not be used in the system of Fumarolo because such a Bluetooth system would most likely not have the distance or range needed to carry out the principle of operation of Fumarolo.” (App. Br. 5.)

We disagree with the Appellants’ contention. We find Bork expressly discloses the argued limitations of a device utilizing Bluetooth signals and GPS for communication (FF 2). We also find that both Fumarolo and Bork disclose utilizing group communications in a limited geographic area such as several streets (FF 2) or a shopping mall (FF 3).

In our view, the combination of familiar elements, for example, a communication unit based on GPS combined with elements to communicate using the well known Bluetooth communication protocol, is nothing more than a “predictable use of prior art elements according to their established functions.”<sup>1</sup>

## VI. CONCLUSION

Based on the administrative record before us, the Appellants have not shown that the Examiner erred in determining that the combination of

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<sup>1</sup> See *KSR*, 550 U.S. at 417.

Fumarolo and Bork discloses the argued limitations in the representative claim 19.

Accordingly, we sustain the Examiner's obviousness rejection of independent claim 19. We also sustain the Examiner's obviousness rejection of independent claim 32, which has not been separately argued. Dependent claims 3-5, 30-31, and 33-37 fall with the corresponding base claims. 37 C.F.R. § 41.37(c)(1)(vii) (2007). *In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

## VII. DECISION

We affirm the rejection of claims 3-5, 19, and 30-37 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

msc

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